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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,941	02/15/2001	Ned M. Smith	42390P10462	4183

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EXAMINER

HOMAYOUNMEHR, FARID

ART UNIT PAPER NUMBER

2132

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,941

Applicant(s)

SMITH ET AL.

Examiner

Farid Homayounmehr

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 1/3/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 11, 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 12-14 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: application 09784941, filed 2/15/2001; last amendment filed 1/3/2006.

2. Claims 10, 12-14 and 19 are pending in the case. Claims 1-9, 11, 15-18 are cancelled.

Response to Arguments

3. Applicant's arguments filed 1/3/2006 have been fully considered.

3.1. Applicant's arguments with respect to rejections under 35 USC 103(a) has been fully considered, but are not persuasive. Applicant contends that Ludwig (Examiner's cited prior art for 103 rejection) does not make any suggestion for ancillary services to make a prima facie case of obviousness. In particular, Applicant contends that archiving and auditing, as two examples of ancillary services, are not suggested by Ludwig. Applicant mentions that paragraph 65 of Ludwig only suggests storing the time at which the role certificate was issued, when it is expired etc. and does not suggest auditing or archiving.

However, the last sentence of Ludwig paragraph 65 reads: 'Each signed role certificate is also stored in the role certificate database.' This clearly suggests a database that is used for archiving the role certificates. In addition, Ludwig paragraph 112 teaches a Digital Document Database that stores all information. Ludwig paragraph 112 teaches a procedure which allows verification of data, which is clearly a suggestion for auditing procedures. In addition, claim 24 section (b) teaches means for retrieving details of transactions from the Digital Document Database, which discloses archiving and auditing.

The above references indicate that Ludwig does suggest auditing and archiving, therefore, making a prima facie case of obviousness. In addition, it is worth mentioning that Ludwig subject matter is related to electronic transactions in e-commerce. Auditing and archiving are integral parts of any typical e-commerce transaction system.

See the following section for detailed explanation of claim limitations based on the referenced prior art, which includes new limitations from the amended claims.

Claim Objections

4. Claim 19 is objected to because of the following informalities: The claim is dependent on a cancelled claim (15). Appropriate correction is required. As indicated in the last paragraph Argument section (page 6 of the Applicant Argument dated 1/3/06),

claim 19 is dependent on claim 10. For the purpose of this prosecution, Examiner assumes claim 19 is dependent on claim 10.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10, 12-14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2001/0021928 A1 to Ludwig (referenced cited in the office action dated 4/6/2005).

6.1 Claims 1 to 9 are canceled.

6.2. As per claim 10, Ludwig is directed to an electronic contract (role certificate as described in paragraph 65) associating at least two parties with a shared process (paragraph 6) comprising: a first section to specify at least one party, other than the at least two parties, that represents a name space corresponding to a domain of cryptographic keys (in Fig. 10 the Transaction Authority is shown as one of the fields in the Role Certificate. The Transaction Authority represents the domain of keys, as described in paragraphs 93 and 11);

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a second section to associate the at least two parties liable under the electronic contract with a public key of a cryptographic key pair from the domain for each of the at least two parties (Fig 10 item 120 which associates the user with the role certificate, see paragraph 65),

a third section to provide at least one of mapping of role names and sub-processes of the shared process, the electronic contract binding public keys for each of the parties with sub-processes (Fig. 10 and paragraph 65 indicating use of keys to authenticate certificate owners and prove their authority to perform transactions, also see response to claim 1);

and a fourth section to allow each of the at least two parties to digitally sign at least a portion of the electronic contract with a private key of the cryptographic key pair for each of the at least two parties (paragraph 115);

a fifth section to specify information identifying at least one of the electronic contract and current revision level (As described in paragraph 65, the role certificate consist of several sections, one of which is administrative information. It would be obvious to a person skilled in art to use that section for any administrative information such as contract identification and current revision level. Also see Fig. 7 item 64, where the electronic contract is clearly identified by its title: "IBM Travel Request"); and

a sixth section defining ancillary services used in support of the shared process, the ancillary services including at least one of saving archives relating to use of the shared process by the at least two parties and performing audits relating to use of the shared process by the at least two parties (claim 24 section b teaches a database that stores

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details of transactions (archiving) and means to obtain that information (auditing). Also paragraphs 112 and 115 disclose archiving data in Digital Document Database and verification capabilities)

6.3. Claim 11 is cancelled.

6.4. As per claim 12, Ludwig is directed to an electronic contract of claim 10, wherein the first section specifies a security standard used for unambiguous references to process definitions, protocols and names from which syntax and semantics of shared processes are derived (process definitions, protocols and names from which syntax and semantics of shared processes are derived can be all identified in the Transaction Authority, which is part of the Role Certificate. It would be obvious to a person skilled in art to use that field to point out security standards to identify protocols and process definitions, as exemplified in paragraph 7).

6.5. As per claim 13, Ludwig is directed to the electronic contract of claim 10, wherein the second section comprises at least one of a contract identifier, validity period, creation date, and contact information of the at least two parties (As described in paragraph 65, the role certificate consist of several sections, one of which is administrative information. It would be obvious to a person skilled in art to use that section for any administrative information such as contract identifier, validity period, creation date, and contact information of the at least two parties).

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6.6. As per claim 14, Ludwig is directed to the electronic contact of claim 10, wherein the third section comprises information to specify syntax and semantics of role names (Fig. 10 item 122 and associated text).

6.7. Claims 15 to 18 are cancelled.

6.8. As per claim 19, Ludwig is directed to the electronic contract of claim 10, wherein the sixth section specifies a party, other than the at least two parties, that provides the ancillary services to the at least two parties as part of the shared process (see response to claim 10, where Ludwig suggest one party, other than the at least two parties, that represents a name space corresponding to a domain of cryptographic keys. Therefore, it would be obvious to use a party, other than the two parties to provide ancillary services).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farid Homayounmehr whose telephone number is (571) 272-3937. The examiner can be normally reached on 9 hrs Mon-Fri, off Monday biweekly.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

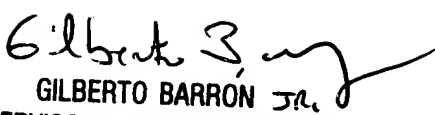
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Farid Homayounmehr

11/1/2005


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